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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,576	08/31/2000	Anthony W. Ulwick	9509.4824	4429

7590 07/26/2004

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EXAMINER

KAZIMI, HANI M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/652,576

Applicant(s)

ULWICK, ANTHONY W.

Examiner

Hani Kazimi

Art Unit

3624

HWW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This application has been reviewed. Original claims 1-10, are pending. The objections and rejections cited are as stated below:

### ***Specification***

2. The abstract of the disclosure is objected to because, it contains legal phraseology often used in patent claims, such as "means" and "said". These terms should be avoided. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4. Claims 1-10 are rejected under the judicially created doctrine of double patenting over claims 1-19 of U. S. Patent No. 5,963,910.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of claims 1-10 of the instant application are taught in the claims of the issued patent. Thus, the claims in the instant application are not patentably distinct from the U.S. Patent and are in fact the generic to the issued species claim.

Claims 1-10 essentially repeat all the features listed in claims 1-19 of US Patent No. 5,963,910. The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claims, the deletion of elements from the patented claims would have been an obvious expedient as above (e.g.), the deletion of claims 10-17 and claimed limitations such as "--- to allow the user to select an optimal one of a plurality of

strategic options designed to solve the selected mission prior to implementation of any option ---" from the patented claims would have been an obvious expedient.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6. Claims 1-10 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-10 are rejected under 35 U.S.C. § 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-ambble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

"A computer implemented method for ---", or something similar. Also, in the body of the claim include at least one structural / functional interrelationship which can only be computer implemented.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the

requirements of paragraphs (1), (2), and (4) of section 371<sup>®</sup> of this title before the invention thereof by the applicant for patent.

8. Claims 1, and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Case et al. (U.S. Patent No. 5,734,890).

Claim 1, Case discloses a method for optimizing strategic options designed to solve a selected mission, comprising the following steps:

(a) processing data relating to subject specific desired outcomes for at least one predetermined customer set, said desired outcomes having predetermined prioritized ratings (column 2, table 1; and, lines 16-22);

(b) processing data relating to predictive metrics which predict satisfaction of said desired outcomes (column 6, line 66 thru column 7, line 6);

(c) evaluating the degree to which each of said predictive metrics predict satisfaction of each of said desired outcomes for each of said customer sets (column 15, lines 26-42);

(d) defining strategic options, each of said defined strategic options designed to satisfy at least one of said customer desired outcomes (column 3, lines 52-64); and

(e) comparing each of said user defined strategic options with a user defined baseline strategic option to determine which of said user defined strategic options best predict satisfaction of each of said customer desired outcomes (column 20, lines 2-15).

Claim 3, Case teaches the steps of prioritizing each of said defined strategic options into said prioritized ratings (column 16, lines 20-28); and  
creating new strategic options to compare with previously defined strategic options (column 12, lines 36-42).

Claim 4, Case teaches the step of identifying specific strengths and weaknesses of each of said defined strategic options, and allowing the user to create new strategic options (column 17, lines 29-50).

Claim 5, Case teaches that the data relating to said customer desired outcomes is obtained by a method including the following steps:

identifying a customer set (column 10, lines 6-8);

interviewing a statistically representative sample of individual customers from said customer set whereby customer desired outcomes, identifying specific benefits that said customer set values, are obtained including the importance of each of said desired outcomes and the degree to which each of said desired outcomes is currently satisfied (column 10, lines 6-21);

quantifying said desired outcomes by ranking said desired outcomes in terms of prioritized importance such that desired outcomes identified by said customer set as important yet unsatisfied are ranked high while outcomes identified by said customer set as unimportant or satisfied are ranked low (table 1; and column 9, lines 24-52).

storing said desired outcomes (column 10, lines 42-51).



Claim 6, Case teaches that the data relating to said metrics which predict satisfaction of said customer desired outcomes is obtained by a method including the following steps:

defining a predictive metric for each desired outcome identified by said customer set (column 6, line 66 thru column 7, line 6);

establishing relationships between each of said desired outcomes and each of said predictive metrics by assigning each predictive metric a representative value depending upon the degree to which said predictive metric predicts satisfaction of each of said desired outcomes (column 15, lines 26-42);

(c) storing said predictive metrics and said assigned values (column 18, line 61 thru column 19, line 3).

Claim 7, Case teaches the step of selecting a specific subject of interest from a plurality of subjects of interest and a specific mission from a plurality of missions related to said select subject of interest, said selected mission being selected for strategic evaluation (column 14, lines 14-24).

Claim 8, Case teaches the step of ranking said predictive metrics in relation to said desired outcomes utilizing matrix analysis for determining the relationship between each of said desired outcomes and each of said predictive metrics for each selected customer set to identify those predictive metrics which predict the highest degree of

desired outcome satisfaction factoring in said predetermined prioritized ratings of said desired outcomes (column 9, line 53 thru column 10, line 5).

Claim 9, Case teaches a method for finding the optimal solution that will satisfy strategic personal and business decisions related to the selected process, comprising the following steps:

(a) storing data obtained from conducting interviews of a statistically representative sample of individual customers from a plurality of customer sets in connection with specific processes, said data comprising a plurality of desired outcomes from said customer sets, each of said desired outcomes having an associated importance factor and an associated satisfaction factor, said satisfaction factor indicating the degree to which a corresponding desired outcome has been achieved (column 10, lines 6-21, and lines 42-51); said data including a plurality of predictive metrics, each of said predictive metrics having a corresponding relationship with each of said desired outcomes, said predictive metrics comprising measurable parameters which predict the satisfaction of said desired outcomes, each of said predictive metrics assigned scaled indicator for each of said desired outcomes, said scaled indicators representing the degree to which each predictive metric satisfies a corresponding particular customer desired outcome (column 9, line 53 thru column 10, line 5);

(b) selecting the specific process to be evaluated for optimization in accordance with said data (column 10, lines 6-21);

(c) selecting a plurality of customer sets for evaluation of said selected process (column 14, lines 14-24);

(d) weighting the importance of said selected customer sets by assigning each of said selected customer sets a weighting value (column 9, line 53 thru column 10, line 5);

(e) ranking said desired outcomes associated with said selected process and said selected and weighted customer sets, whereby said desired outcome ranking is dependent upon said customer set weighting values and said importance and satisfaction factors such that desired outcomes identified as important yet unsatisfied are ranked higher than desired outcomes identified as unimportant or satisfied (table 1; and column 9, lines 24-52);

(f) prioritizing said predictive metrics in terms of the degree to which said predictive metrics predict the satisfaction of said desired outcomes associated with said selected customer sets and said selected process, whereby those predictive metrics which predict satisfaction of said ranked desired outcomes are quantified and prioritized (column 9, line 53 thru column 10, line 5);

(g) defining a plurality of process specific strategic options, each of said strategic options designed to satisfy said customer desired outcomes (column 3, lines 52-64);  
and

(h) quantifying the degree to which each of said strategic options satisfy said customer desired outcomes (column 20, lines 2-15).

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

11. Claims 2, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Case et al. (U.S. Patent No. 5,734,890) in view of Gartner Group Executive Services "Executive Market Analysis Program" EMAP pp. 11-36).

Claim 2, Case fails to explicitly teach the step of quantifying the degree to which each of said strategic options satisfy said customer desired outcomes by comparing the degree to which each of said defined strategic options positively or negatively incorporate said predictive metrics, said quantification means comparing each of said defined strategic options to said preselected base line option thereby yielding a strategic option which best satisfies said customer desired outcomes.

However, Gartner Group teaches the step of quantifying the degree to which each of said strategic options satisfy said customer desired outcomes by comparing the degree to which each of said defined strategic options positively or negatively incorporate said predictive metrics, said quantification means comparing each of said defined strategic options to said preselected base line option thereby yielding a strategic option which best satisfies said customer desired outcomes (page 14).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Case to include the step of quantifying as taught in Gartner Group, support for the combination is mentioned in Case et al. (U.S. Patent No. 5,734,890, column 4, lines 50-67).

Claim 10, Case teaches a method for evaluating and optimizing business strategies in connection with a data storage device containing data obtained from conducting interviews of a statistically representative sample of individual customers from a plurality of said discrete customer sets, whereby desired outcomes, identifying benefits that each customer set values, are elicited and stored in said database in discrete files corresponding to said customer sets, each of said desired outcomes having an assigned importance factor and an assigned satisfaction factor (column 10, lines 6-21, and lines 42-51); said data storage device further including predictive metrics for each of said desired outcomes identified by each of said customer sets, said predictive metrics comprising measurable parameters for satisfying said desired outcomes, each of said predictive metrics assigned scaled indicators for each of said

desired outcomes, said scaled indicators representing the degree to which a predictive metric predicts satisfaction of a particular customer desired outcome, said method comprising the following steps:

selecting a plurality of customer sets for analysis (column 14, lines 14-24);

ranking said desired outcomes in terms of importance and satisfaction whereby desired outcomes identified as important yet unsatisfied are ranked high while desired outcomes identified as unimportant or satisfied are ranked low, said cumulative ranking being dependent upon said customer set weighting (table 1; and column 9, lines 24-52); outcome (column 9, line 53 thru column 10, line 5);

prioritizing said predictive metrics, said prioritization dependent upon said cumulative ranking of desired outcomes and dependent upon said predictive metric scaled indicators whereby the predictive metrics which predict satisfaction of high ranked desired outcomes are assigned a high priority while the predictive metrics which predict satisfaction of low ranked desired outcomes are assigned a low priority (column 9, line 53 thru column 10, line 5);

displaying a list of said predictive metrics prioritized in terms of normalized importance relative to said ranked desired outcomes (column 14, line 61 thru column 15, line 12);

defining a plurality of strategic options (column 8, line 49 thru column 9, line 11);  
and

evaluating each of said defined strategic options in terms of the degree to which each defined strategic options satisfies said desired outcomes (column 15, lines 26-42).

Case fails to explicitly teach the step of assigning weighting values to said selected customer sets thereby positively or negatively weighting the influence of each of said selected customer sets.

However, Gartner Group teaches the step of assigning weighting values to said selected customer sets thereby positively or negatively weighting the influence of each of said selected customer sets (page 14).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Case to include the step of assigning weighting values to said selected customer sets thereby positively or negatively weighting the influence of each of said selected customer sets as taught in Gartner Group, support for the combination is mentioned in Case et al. (U.S. Patent No. 5,734,890, column 4, lines 50-67).

### ***Conclusion***

**12.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**

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June 28, 2004